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ERNEST A. BEUTLER, ATTORNEY AT LAW 10 RUE MARSEILLE NEWPORT BEACH, CA 92660			TAMAI, KARL I	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040422

Application Number: 10/064,363
Filing Date: July 07, 2002
Appellants: TAKANO ET AL.

10/064,363
Ernest Beutler
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/09/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying NO related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct. The examiner notes the summary does not refer to the specification by line and page number.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1 and 4-6 do not stand or fall together because appellant's brief includes a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

<u>Patent Number</u>	<u>Inventor</u>	<u>Publication Date</u>
5,763,978	Uchida et al.	6/1998

(10) *Grounds of Rejection*

The following grounds of rejection are applicable to the appealed claims:

Claims 1 and 4-6 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper dated 7/30/2003. The rejection is repeated below for the convenience of the Board of Appeals and Interferences.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (U. S. Pat. 5,763,978). Uchida et al. disclose an armature (in figures 1-3) for a rotating machine having: a circular core (16) of a magnetic material and a plurality of magnetic pole teeth (18) extending radially from the circular core (16) and terminating at terminal ends spaced from the circular core (16), each of the magnetic pole teeth (18) defining a core and an enlargement (24) formed at the terminal end of the core, to define slots (20) formed between adjacent magnetic pole teeth (18), each of the slots (20) having a mouth (26) formed between adjacent enlargements (24), an insulating bobbin having a circular portion (30) lying on one side of said circular core (16) and leg portions (18a) that extend for the length of said pole teeth (18) at least on the sides of said slots (20) and insulator portions (32,36) extending at least along the

side of the enlargements (24) facing the circular core (16). Uchida et al. disclose that the insulator portions (32,36) have a greater thickness than the insulating bobbin leg portions (18a in figure 2). Uchida et al. disclose that the insulator portions (32,36) define an open slot (20 at 32a) that receives the winding nozzle tip (42 in figure 2). Uchida et al. disclose that the open slot (20) is formed between portions of the insulator portions (32,36) that define an opening smaller than the diameter of the received winding nozzle tip (42). However, Uchida et al. do not explicitly writes that the wires are protected from the winding needle.

It would have been obvious for a person with ordinary skill in the art at the time the invention was made to understand from Uchida et al. that the windings (figures 1 and 2) are not being damaged by the nozzle (42) since the insulators (32,36) are holding the nozzle (42) away from the windings and towards the center of the slot (20). The examiner notes that no patentable weight has been given to the method of manufacturing limitations (i. e. "formed by a winding needle") since "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

(11) Response to Argument

The Applicant's argument that the insulating material must contact the needle and wire during operating is not persuasive because the Applicant has not claimed winding without contact and because the limitation is a method of making limitation which is not germane to the patentability of the apparatus. The Applicant's argument that the limitation of the "insulator portions extending at least along the side of the enlargements facing the circular core" must include a space is not persuasive because the claim does not include such a space limitation. Uchida clearly shows the insulator 32 on the enlargements 24 of the teeth facing the circular portion of the core 16 as set forth by Claim 1.

The Applicant's argument regarding the purpose of the invention is not persuasive because the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In the instant application, Uchida teaches the insulation on the slot at the enlargement to provide desired electrical insulation without hindering the windings operation (col. 6, line 35) and allows windings to be installed in the vicinity of the hooks 24 to increase the space factor of the windings in the slot (col. 6, line 22), therefore any additional benefit of protecting the windings from the needle in the vicinity of the hooks 24 by insulation 24 naturally flows from the disclosed limitations. The examiner notes that the purpose of the insulation on the enlargements is not a structural limitation, but merely a recitation of intended use.

The Applicant's question regarding how the wires are protected when they are rubbed during the winding operation is not persuasive because the limitation of being wound without rubbing has not been claimed. The limitation is a method of making limitation which is not germane to the patentability of the apparatus.

The Applicant's argument the Uchida does not teach the thickness of the insulator portions being larger than the bobbin leg portions is not persuasive. Uchida teaches the insulator portions being 32 and 36, which as shown in figures 2 and 3 have varying thickness. It is clear from figure 3 that the varying thickness at 32 and 36 are thicker than the thin bobbins sides 18a. The examiner notes that Applicant's argument is not persuasive because Claim 4 merely requires the insulator portions to be thicker than the bobbin leg portions, but does not require the insulator portions at the extending at the side of the enlargement to be thicker than the bobbin legs. Therefore Uchida meets the limitation at reference number 32 and 36 as set forth in the final office action. The examiner notes even if the limitation of the thickness at the enlargements 24 being thicker than the bobbin leg, then figure 4b shows the leg portions 32a being formed thicker than the bobbin legs 30 at the end of the enlargements 24 and thinner at the center of the slot.

The Applicant's argument that figure 2 shows the deformation by the wire is not persuasive because the specification refers to the element 42 (col. 6, line 17) as the nozzle (needle) of the automated winding machine, and therefore Uchida teaches the limitation of claim 5. The Applicant's argument that Uchida does not teach the opening between the insulating sections 32 is smaller than the diameter of the winding needle

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42. The examiner disagrees. Figure 2 clearly shows the opening between the insulators 32 being a mere line which is smaller than the nozzle/needle 42, and therefore teaches the limitation of claim 6.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**KARL TAMAI
PRIMARY EXAMINER**

Karl I.E. Tamai
Primary Examiner
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April 27, 2004

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